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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,858	11/16/2001	Yoshinori Nakamura	FUJS 14.330A	1241

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EXAMINER
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NGUYEN, PHUONGCHAU BA

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

22

## Office Action Summary

Application No.

09/989,858

Applicant(s)

NAKAMURA ET AL

Examiner

Phuongchau Ba Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/880,723.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-31-2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 18–19 are rejected under the judicially created doctrine of obviousness–type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,385,213. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims 18–19, 21–22 merely broaden the patented claim 1 by eliminating "a data switch section"(col.31, lines 19–24, 36–42). Likewise, the application claims 20 and 23 merely broaden the patented claim 1 by eliminating "a data switch section"(col.31, lines 19–24, 36–42).

It would have been obvious to one skilled in the art at the time invention was made to eliminate limitations that are not unnecessary for their invention and to rephrase elements so long as the unit or element under different name would perform the same function.

Also, it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference's element whose function is not needed would be obvious to one skilled in the art.

*Claim Rejections – 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 18–23 are rejected under 35 U.S.C. 102(e) as being anticipated by Suh (5,710,774).

Regarding claim 18,

Suh (5,710,774) discloses a frame synchronous pattern detection apparatus, for detecting an actual frame synchronous pattern which is a part of a frame synchronous pattern and is essential to execute frame synchronizing, comprising:

- a) a provisional region detection section (selecting circuit 60, fig.1);
- b) a frame synchronous pattern detecting section (synchronizing pattern detecting circuit 90, fig.1)

said provisional-region detection section being for sampling, from parallel data according to a synchronous digital hierarchy (SDH) transmission system, a part of the parallel data in which said actual frame synchronous pattern is presumably included, as provisional region data and for outputting the provisional region data in serial form to said frame synchronous pattern detecting section (col.3, line 65–col.4, line 1),

said frame synchronous pattern detecting section, communicatively connected with said provisional-region detection section, for detecting said actual frame synchronous pattern from the inputted provisional region data (col.4, lines 4–29).

Regarding claim 19,

Suh discloses a frame synchronous pattern detection apparatus for detecting an actual frame synchronous pattern which is a part of a frame synchronous pattern and is essential to execute frame synchronizing, comprising:

a) a provisional-region detection section (selecting circuit 60, fig.1); and  
b) a frame synchronous pattern detecting section (synchronizing pattern detecting circuit 90, fig.1),

said provisional-region detection section being for sampling, from given data, a part of parallel data in which said actual frame synchronous pattern is presumably included, as provisional region data, and for outputting the provisional region data in serial form to said frame synchronous pattern detecting section (col.3, line 65–col.4, line 1),

said frame synchronous pattern detecting section, communicatively connected with said provisional-region detection section, for detecting said actual frame synchronous pattern from the inputted provisional region data (col.4, lines 4–29).

Regarding claim 20,

Suh discloses a frame pattern detection method, for detecting an actual frame synchronous pattern which is a part of a frame synchronous pattern and



is essential to execute frame synchronizing, said method comprising the steps of:

sampling, from given parallel data, a part in which said actual frame synchronous pattern is presumably included, as provisional region data (selecting circuit 60—fig.1, col.3, line 65—col.4, line 1); and

detecting said actual frame synchronous pattern from said sampled provisional region data converted into serial form (synchronizing pattern detecting circuit 90—fig.1, col.4, lines 4–29).

Regarding claim 21,

Suh discloses a frame synchronous pattern detection apparatus comprising:

a) a provisional–region detection section for sampling, from parallel data according to a synchronous digital hierarchy (SDH) transmission system, a part of the parallel data in which an object frame synchronous pattern is presumably

included, as provisional region data (selecting circuit 60-fig.1, col.3, line 65-  
col.4, line 1); and

b) a frame synchronous pattern detecting section for detecting, from said  
provisional region data, the object frame synchronous pattern (synchronizing  
pattern detecting circuit 90-fig.1, col.4, lines 4-29),

said provisional region data being output in serial form from said  
provisional region detection section to said frame synchronous pattern  
detecting section (col.4, lines 23-29).

Regarding claim 22,

Suh discloses a frame synchronous pattern detection apparatus  
comprising:

a) a provisional-region detection section for sampling, from given data, a  
part of parallel data in which an object frame synchronous pattern is  
presumably included, as provisional region data (selecting circuit 60-fig.1,  
col.3, line 65-col.4, line 1); and

b) a frame synchronous pattern detecting section for detecting, from said provisional region data, the object frame synchronous pattern (synchronizing pattern detecting circuit 90-fig.1, col.4, lines 4-29),

said provisional region data being output in serial form from said provisional-region detection section to said frame synchronous pattern detecting section (col.4, lines 23-29).

Regarding claim 23,

Suh discloses a frame synchronous pattern detection method comprising the steps of:

sampling, from a given parallel data, a part in which an object frame synchronous pattern is presumably included, as provisional region data (selecting circuit 60-fig.1, col.3, line 65-col.4, line 1); and

detecting the object frame synchronous pattern using said sampled provisional region data converted into serial form (synchronizing pattern detecting circuit, col.4, lines 4-29).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is 571-272-3148. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Phuongchau Ba Nguyen  
Examiner  
Art Unit 2665

DUCHO  
PRIMARY EXAMINER



1-13-06